



UNITED STATES PATENT AND TRADEMARK OFFICE

A

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,324	12/24/2001	Noriyasu Nakamura	P/2856-25	8048

32172 7590 12/16/2005

DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
1177 AVENUE OF THE AMERICAS (6TH AVENUE)
41 ST FL.
NEW YORK, NY 10036-2714

EXAMINER

CHUNG, JI YONG DAVID

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/026,324	Applicant(s) NAKAMURA, NORIYASU	
	Examiner Ji-Yong D. Chung	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/2/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

90c

DETAILED ACTION

Response to Remarks

1. Applicant's arguments and amendments filed on September 2, 2005 have been carefully considered but they are not persuasive.

Applicant's arguments are addressed in this section.

Cancellation of **claims 1-4 and 7-9** is duly noted.

In reference to **claims 5**, Applicant indicates that the claimed invention includes a facsimile apparatus that converts image data received from a website to facsimile data suitable for output by a facsimile apparatus. Applicant states that Hamzy reference, cited in the rejection of claim 5, does not teach the claimed feature.

The Office disagrees.

As stated in the prior Office Action, Hamzy reference, from lines 11-42 in column 8, shows that the 'proxy server' ("a predetermined URL transfer terminal") transmits URL to 'a facsimile server' ("facsimile" in claim 5). Note that "facsimile server" has been described in the prior Office Action as "whatever device that the proxy server drives to transmit data."

As mentioned in Hamzy reference, the URL response is directed to a 'facsimile server', which then faxes a copy of the web page to a facsimile machine convenient to a user. In other words, the facsimile server receives HTML data and faxes the same to a fax machine. Because a device that receives HTML data cannot fax that same data without converting it to fax data, it is understood that the fax server performs the data conversion.

Note that in lines 27-42 of column 8, Hamzy mentions another proxy server that is driven by a first proxy server. In the embodiment described in the passage, it is the second proxy server that performs the conversion from HTML data to fax data. See Fig. 2 for both proxy servers.

With reference to **claim 6**, Applicant cites the same reasons for its allowability as one stated for claim 5. However, the same argument cannot apply to claim 6.

In the original Office Action dated April 7, 2005, the claimed element that Applicant currently argues not to be present in Hamzy (with respect to claim 5), has been shown to be present in Eldridge et al. (Pat. No. US 6,421,716).

With respect to **claim 10**, Applicant cites the same reasons for its allowability as one given for claim 5. Applicant states, "Claim 10 is believed to distinguish from Hamzy for at least the same reasons discussed in foregoing paragraphs."

However, Claim 10 has been rejected as being anticipated by Marx reference (US Pat. 6,348,970), not Hamzy. Thus, arguments directed to distinguishing claim 5 from Hamzy do not apply to the rejection of claim 10.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claim 6** stands rejected under 35 U.S.C. 103(a) as being unpatentable over Hamzy in view of Eldridge et al (Eldridge hereinafter).

In reference to **claim 6**, Hamzy shows

a communication network [See lines 33-34, column 4];

a wireless base station connected to said communication network [The base station is not shown directly, but it is inherent in a system for a wireless device mentioned from line 62, column 3 to line 5, column 4. The wireless device *must* communicate through a transceiver gateway];

a website, making available image data via said communication network [See lines 10-26 column 7, for URL and a website];

Hamzy does not show but Eldridge shows the following limitations:

a facsimile connectable to said communication network and to a telephone line, which in a case in which a subject of an electronic mail sent thereto is a URL of said website, accesses said website in accordance with said URL, receives said image data from said website, converts said image data to facsimile communication data, and outputs said data [See item 462 of Fig. 4B for FAX connection and see Token Enabled Servers in Fig. 1. See Fig. 6 for Token aware email server. The token-aware email servers transmit URL (or tokens) instead of documents themselves. The system as revealed by Eldridge takes URL and applies desired services (such as FAX)] and

Art Unit: 2143

a portable terminal, connectable to said communication network via said base station, which sends a URL of said website selected by a user as a subject of an electronic mail to said facsimile. See from line 47, column 7 to line 52, column 8. A portable terminal (mobile computing device) can request services on a selected token, which is transmitted to the server when requesting a service. Available services include FAX service.

It would have been obvious to one of ordinary skill in the art at the time of the invention to install Eldridge's token-aware feature on the proxy server of Hamzy, along with proper modification to the portable terminal, because as Eldridge points out in lines 56-61, column 7, using document tokens (URL's) minimizes the memory requirements of the mobile computing devices as well as the bandwidth required for transmitting information.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claim 5** is rejected under 35 U.S.C. 102(e) as being anticipated by Hamzy.

With respect to **claim 5**, Hamzy shows:

a communication network [See lines 33-34, column 4];

Art Unit: 2143

a wireless base station connected to said communication network [The base station is not shown directly, but it is inherent in a system for a wireless device mentioned from line 62, column 3 to line 5, column 4. The wireless device *must* communicate through a transceiver gateway];

a website, making available image data via said communication network [See lines 10-26, column 7 for URL and a website];

a facsimile connectable to said communication network and to a telephone line, which in a case in which a previously specified URL of said website is sent from a predetermined URL transfer terminal, in accordance with said URL, accesses said website, receives said image data from said website, converts said image data to facsimile communication data, and outputs said data [See proxy server in line 12-42, column 8 and whatever component that the proxy server drives to transmit fax data are taken as “facsimile.” The proxy server is the “predetermined URL transfer terminal.” The “facsimile” is indirectly connected to the portable terminal via a telephone line and the network] *and*

a portable terminal, connectable to said communication network via said base station, which sends a URL of said website selected by a user to said facsimile via said telephone line. The URL is “sent via” said telephone line from the portable terminal to “facsimile” (fax data transmitting means, whether it is a fax server or another proxy server).

Note that the proxy server is “portable,” in the sense that it can be moved about.

6. **Claim 10** is ejected under 35 U.S.C. 102(e) as being anticipated by Marx.

Art Unit: 2143

With respect to **claim 10**, Nicholas shows *a facsimile connectable to a communication network and to a telephone line, which in a case in which a URL of a website is sent from a pre-specified URL transfer terminal, accesses said website in accordance with said URL, receives image data from said website, and converts said image data to facsimile communication data.*

See Fig. 1, items 100 and 102, which correspond to the applicant's fax machine. See from line 47, column 7 to line 10, column 8.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ji-Yong D. Chung whose telephone number is (571) 272-7988. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2143

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ji-Yong D. Chung
Patent Examiner
Art Unit: 2143



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

906